



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/772,781

02/04/2004

Jerry B. Gin

1375-0001.20

2376

23980

7590

12/31/2008

MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C

5 Palo Alto Square - 6th Floor

3000 El Camino Real

PALO ALTO, CA 94306-2155

EXAMINER

ROBERTS, LEZAH

ART UNIT

PAPER NUMBER

1612

MAIL DATE

DELIVERY MODE

12/31/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Advisory Action  
Before the Filing of an Appeal Brief**

<b>Application No.</b> 10/772,781	<b>Applicant(s)</b> GIN ET AL.
<b>Examiner</b> LEZAH W. ROBERTS	<b>Art Unit</b> 1612

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 10 November 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1-8, 12, 13, 23-26, 28, 29, 46-48, 55-57 and 72-74.  
Claim(s) withdrawn from consideration: 9-11, 14-22, 27, 31-45, 49-54, 58-71, and 75-99.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

/Frederick Krass/  
Supervisory Patent Examiner, Art Unit 1612

/Lezah W Roberts/  
Examiner, Art Unit 1612

Continuation of 3. NOTE: The claims recite the new limitation "a plurality of ethylcellulose particles". This limitation was not disclosed in previously submitted claims and requires a further search to determine if the limitation would have been obvious to one of skill in the art at the time the invention was made .

Continuation of 11. does NOT place the application in condition for allowance because: In regards to the 112 New Matter rejection of "does not substantially dissolve", although Applicant has indicated where the phrase finds support, the term substantially is not defined in the original specification and therefore it cannot be concluded what degree of dissolving is encompassed by the term. Furthermore the passage Applicant submits indicates that the lozenge does not dissolve at all which does not appear to support the above limitation.

In regards to the indefinite rejection, the rejection is maintained. The term substantially is not defined in the specification. The specification appears to assert the lozenge does not dissolve at all. Therefore it cannot be ascertained what degree of dissolving is encompassed by "substantially".

In regards to Applicant not defining the wet matrix, the Examiner acknowledges that Applicant has defined the term in the instant specification as being "a matrix that contains a liquid phase that represents a sufficiently large fraction of the matrix to provide a discernibly wet or sticky surface, and/or a soft and rubbery consistency". Although the Examiner has used a dictionary definition of this term, the rejection was based on the flavoring wetting the ethylcellulose and that the flavoring may be included at concentrations up to 200% based on the ethyl cellulose, which encompasses amounts used in the instant invention, therefore the interpretation appears to be in scope with Applicant's definition. Also the compositions may coat lozenges, gums and candies and also may be formulated into films. When the films or coated lozenges are in the mouth, the films and coatings become "wet" thereby encompassing "wet matrices". Further in regards to the reference teaching away from a matrix, it appears to only teach away from solid matrices. When looking to the instant specification to determine what is in the wet matrices of the instant invention to distinguish them from the dispersions of the instant claims, it appears the compositions are similar, wherein the instant invention's compositions appear to require ethylcellulose, flavor oil and sweetener and the compositions of the reference appear to require ethylcellulose, water (which later may be removed) and flavor oil. The compositions of the reference also slowly release the flavoring or fragrance (col. 1, lines 66-68) similar to that of the instant invention. Therefore the compositions of the reference appear to encompass what Applicant asserts is a "wet matrix".